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MAILED

JAN 30 2009

In re Application of :
Durbin, et al. :
Application No. 09/681,017 :
Filed: November 22, 2000 :
Attorney Docket No. GEMS8081.023 :
For: METHOD AND SYSTEM TO REMOTELY
ENABLE SOFTWARE-BASED OPTIONS FOR
A TRIAL PERIOD

OFFICE OF PETITIONS

ON PETITION

This is a decision on the renewed petition, filed January 6, 2009, under 37 CFR 1.183 to waive the necessity for the signatures of all joint inventors on a 37 CFR 1.131 declaration, the renewed petition under 37 CFR 1.48(a) to correct the inventorship of the above-identified application by the addition of four joint inventors, and the renewed petition under 37 CFR 1.183 requesting waiver of 37 CFR 1.48(a)(3), which requires submission of an oath or declaration signed by the actual inventors.

The petition under 37 CFR 1.183 to waive 37 CFR 1.131 is **granted**.

The petition under 37 CFR 1.48(a) is **granted**.

The petition under 37 CFR 1.183 requesting waiver of 37 CFR 1.48(a)(3) is **granted**.

A declaration, filed on February 12, 2001, listed three joint inventors: Winnie Durbin, Kun Zhang, and Karamjeet Singh.

Petitioners wish to add David T. Mehring, Thomas L. Lamoureaux, Hubert A. Zettel, and Timothy D. Butler as joint inventors.

37 CFR 1.48(a) requires that an amendment to the named inventive entity be accompanied by: (1) a petition setting forth the desired change in inventorship, (2) including a statement from each person being added and from each person being deleted as an inventor that the error occurred without deceptive intention on his or her part; (3) an oath or declaration by each actual inventor or inventors as required by 37 CFR 1.63 or as permitted by 37 CFR 1.42, 1.43 or 1.47; (4) the fee set forth in 37 CFR 1.17 (i); and (5) the written consent of any existing assignee, if any of the originally named inventors has executed an assignment.

The declaration filed on May 12, 2008 lacks signatures from the original three joint inventors. Inventor Zhang's execution is excused because it has been established that he cannot be located. See petition decision, October 12, 2007, Page 1.

The petition under 37 CFR 1.183 requesting waiver of the execution of the declaration for patent application by Inventors Singh and Durbin is evaluated as to whether the non-signing inventors could not be reached/refuse to cooperate. In essence, petitioners must show that the inability to again obtain an executed declaration from the non-signing inventors is, notwithstanding the exercise of reasonable care and diligence, due to circumstances beyond their control.

Considering all filed petitions as a whole, petitioners have established that Inventors Singh and Durbin cannot be located/refuse to cooperate.

The petition requesting waiver under 37 CFR 1.183 of the requirement in 37 CFR 1.48(a)(3) for the execution of the new declaration for patent application by Inventors Singh and Durbin is granted. The petition under 37 CFR 1.48(a) is granted. Please find enclosed a corrected filing receipt reflecting the change in inventorship.

Petitioners assert that the three original joint inventors cannot be located to join in the execution of a declaration under 37 CFR 1.131. It has been established that Inventor Zhang cannot be located. Petitioners have established that Inventors Durbin and Singh cannot be located/refuse to execute the declaration under 37 CFR 1.131. The petition under 37 CFR 1.183 to waive 37 CFR 1.131 is granted.

After the mailing of this decision, the application will be returned to Technology Center 3621 for further examination.

Telephone inquiries regarding this communication should be directed to the undersigned at (571) 272-3230.



Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

Enclosure: corrected filing receipt